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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/684,905	10/14/2003	James W. Voegelé	END 788DIV	3568
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PHILIP S. JOHNSON JOHNSON & JOHNSON ONE JOHNSON & JOHNSON PLAZA NEW BRUNSWICK, NJ 08933-7003			EXAMINER FOREMAN, JONATHAN M	
			ART UNIT	PAPER NUMBER
			3736	
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			01/09/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/684,905

Applicant(s)

VOEGELE ET AL.

Examiner

Jonathan ML Foreman

Art Unit

3736

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 6-8 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 6-8 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. ____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date ____ | 6) <input type="checkbox"/> Other: ____ |

DETAILED ACTION

Claim Objections

1. Claim 7 is objected to because of the following informalities: line 13 states “detachable” instead of “detachably”. Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 6 – 8 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1, 2 and 4 of U.S. Patent No. 6,656,133. Although the conflicting claims are not identical, claims 6 - 8 are merely broader in scope than claims 1, 2 and 4 of U.S. Patent No. 6,656,133. As such, claims 1, 2 and 4 of U.S. Patent No. 6,656,133 “anticipate” the subject matter of currently pending claims 6 - 8. Accordingly, claims 6 - 8 are not patentably distinct from claim s 1, 2 and 4 of U.S. Patent No. 6,656,133.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national application published under section 122(b) only if the international application designating the United States was published under Article 21(2)(a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claim 6 is rejected under 35 U.S.C. 102(b) as being anticipated by U.S. Patent No. 5,779,723 to Schwind.

In reference to claim 6, Schwind discloses a biopsy instrument (Figure 1) comprising: a base assembly (4); a probe assembly (2) detachably mounted to the base assembly, the probe comprising: a cutter assembly comprising: a cutter (11); a gear mechanism (Col. 3, line 66 – Col. 4, line 5) adapted to move the cutter; a piercer assembly comprising: a piercer (11); a probe mount; a drive assembly detachably mounted to the cutter assembly , the drive assembly comprising: a flexible

drive shaft (6, Col.4, lines 7 – 9); a transmission operatively connected to a distal end of the flexible drive shaft (6) and operatively connected to said gear mechanism.

5. Claims 6 and 7 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 5,980,545 to Pacala et al.

In reference to claims 6 and 7, Pacala et al. disclose a biopsy instrument comprising: a base assembly including a firing mechanism (Col. 9, lines 17 – 20); a probe assembly detachably mounted to the base assembly, the probe comprising: a cutter assembly comprising: a cutter (20); a gear mechanism adapted to move the cutter (Col. 5, lines 8 – 31; Col. 7, line 49 – Col. 8, line 5); a piercer assembly comprising: a piercer (116, 118) including a cutter lumen adapted to receive the cutter; a probe mount adapted to slideably connect the piercer to the cutter assembly; a drive assembly detachably mounted to the cutter assembly, the drive assembly comprising: a flexible drive shaft (176); a transmission adapted to transmit motion from a distal end of the flexible drive shaft to the gear mechanism.

6. Claims 6 and 8 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,120,462 to Hibner et al.

In reference to claim 6, Hibner et al. disclose a biopsy instrument comprising: a base assembly (140); a probe assembly (40) detachably mounted to the base assembly, the probe comprising: a cutter assembly comprising: a cutter (96) ; a gear mechanism adapted to move the cutter (Col. 9, lines 6 – 21); a piercer assembly comprising: a piercer (70); a probe mount; a drive assembly (Figure 5) detachably mounted to the cutter assembly, the drive assembly comprising: a flexible drive shaft (Col. 7, lines 18 - 20); a transmission operatively connected to a distal end of the flexible drive shaft and operatively connected to said gear mechanism (Col. 11, lines 14 – 50).

In reference to claim 8, Hibner et al. disclose a transmission assembly for a medical instrument including a rotation coupling assembly including a rotation drive coupling; a translation coupling assembly including a translation drive coupling and an encoder assembly (Col. 11, lines 14 – 56).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jonathan ML Foreman whose telephone number is (571)272-4724. The examiner can normally be reached on Monday - Friday 8:00 am - 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on (571)272-4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


JMLF

